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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,496	03/15/2005	Georg Ignatius	F-8307	4527
20151 7590 12/22/2008 HENRY M FEIEREISEN, LLC HENRY M FEIEREISEN 708 THIRD AVENUE SUITE 1501 NEW YORK, NY 10017				
EXAMINER				
PIERCE, WILLIAM M				
ART UNIT		PAPER NUMBER		
3711				
MAIL DATE		DELIVERY MODE		
12/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/500,496

Applicant(s)

IGNATIUS, GEORG

Examiner

William M. Pierce

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-50 is/are pending in the application.
4a) Of the above claim(s) 40,44,45 and 50 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 35-39,41-43 and 46-49 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Newly submitted claims 40, 41, 44, 45 and 50 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: As to claims 40, 44 and 45 previously presented claims respectively do not call for the removal of material from the actuating part, additional element of a lengthwise extending recesses and material removed along lengthwise extending recesses. Where previously presented claim 12 recited "a geometric series", these originally presented claims did not call for $l * x^n$ as called for in claim 50. The remarks of 12/17/2007 at the bottom of pg. 15 and 3/2/07 top of pg. 19 are directed to the embodiment having a harmonic series. Elements of substantially equal length independent of their location as called for in claim 41 is not previously presented.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 40, 41, 44, 45 and 50 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Where original claims 13-16 call for superimposed series, such is considered commensurate with the scope of new claim 36 that calls for two or more harmonic series as such these claim do not appear to differ in scope from those originally claimed.

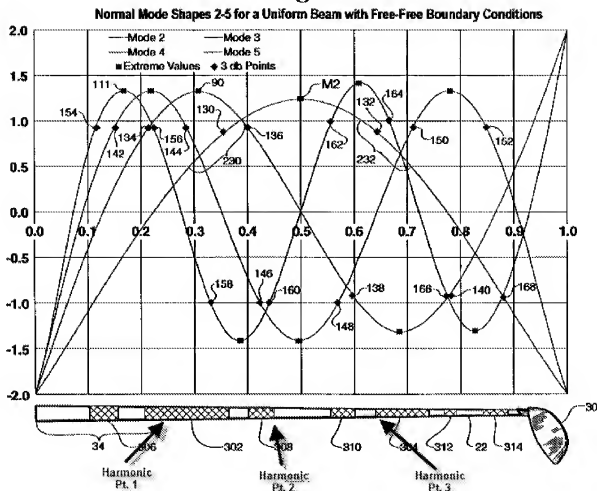
The issues surrounding the instant application appear to center around the "locations" of "variations" or "modifications" made to the shaft as called for in claim 35. Claim 35 is considered generic to how these "active elements" are formed. Should allowable subject matter in their location be found that distinguishes over that art of record, the manner in which these variations are formed (claims 40, 44, 45) by either embodiment of adding or removing material could be requested to be rejoined.

Claim Rejections - 35 USC § 102

Claims 35-39, 42, 43, 46 and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Wright as set forth below.

Where claims 35 and 49 now calls for the spacing of the locations of the active elements and the spacing between a location and an adjacent end to follow a harmonic series l/n . Most broadly, the scope of this limitation is such that the location of any number of active elements from a first end and second end must be equal. Wright is still considered to meet this limitation were at harmonic points 1-3 shown below are considered locations having an active element 302, 308 and 304.

Fig.8



As to claim 36, fig. 8 above shows a third harmonic. The locations of the active elements are also considered to be defined by a sixth harmonic series. Each element above differs in a dampening parameter based upon their different length as called for in claim 37. The elements shown above are considered over less than the length of the actuating part as called for by claim 38. The stiffeners of Wright are formed by applying

additional material as called for by claim 39. At least 5 elements are shown as called for in claim 42 and stiffeners of Wright are considered a "film coating" as called for by claim 43. Metal is shown at col. 5, ln. 33 as called for by claim 46.

Where the examiner recognizes that applicant's claims may be narrowed, for example, to recite amendments such that the that the locations or a "center point" on the active elements, an alternate rejection applying Monette has been applied as follows.

Claims 35-39, 42, 43, 46 and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Monette 5,683,308.

As to claim 35, 37-39, 42 and 48, active elements 40 are considered to be arranged between a first end and second end uniformly spaces where 42 is considered to be the adjacent end. As to claim 36, a second harmonic series is considered show by active elements 40 as called for by claim 36. Claim 43 is considered inherent in Monette where the disks 40 are made of rubber (col, 3, ln. 19) which can be granular. See 4,031,302 by way of example.

As to claim 46, the selection of a material to take advantage of its known properties has been held to be obvious. To have replace the rubber in the discs 40 and 42 of Monette would have been obvious to modify the vibrational response of the shaft. Applicant has not shown where the selection of metal solved any particular problem or produces any unexpected results.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright in view of Yamaguchi 4,928,965.

The applications of vibration modification techniques from one type of sport device to another is well known. See Yamaguchi 4,928,965 who teaches that such designing techniques can be used on a bat, club, racket or paddle for an example.

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Conclusion

Applicant's arguments filed 9/4/08 have been fully considered but they are not persuasive for the reasons set forth above in the new grounds for rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Pierce whose telephone number is 571-272-4414 and E-mail address is bill.pierce@USPTO.gov. The examiner can normally be reached on Monday and Friday 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, communication via email at the above address may be found more effective. Where current PTO internet usage policy does not permit an examiner to initiate communication via email, such are at the discretion of the applicant. However, without a written authorization by applicant in place, the USPTO will not respond via Internet e-mail to any Internet correspondence which contains information subject to the confidentiality requirement as set forth in 35 U.S.C. 122. A paper copy of such correspondence will be placed in the

appropriate patent application. The following is a sample authorization form which may be used by applicant:

"Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me by responding to this inquiry by electronic mail. I understand that a copy of these communications will be made of record in the application file."

For further assistance examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/William M Pierce/

Primary Examiner, Art Unit 3711